
Volume 72
Issue 2 *Dickinson Law Review* - Volume 72,
1967-1968

1-1-1968

Section 113 of the Proposed Copyright Law Revision-A Proposed Amendment to Protect the Utilitarian Aspects of Useful Articles

Gary R. Myers

Follow this and additional works at: <https://ideas.dickinsonlaw.psu.edu/dlra>

Recommended Citation

Gary R. Myers, *Section 113 of the Proposed Copyright Law Revision-A Proposed Amendment to Protect the Utilitarian Aspects of Useful Articles*, 72 DICK. L. REV. 307 (1968).

Available at: <https://ideas.dickinsonlaw.psu.edu/dlra/vol72/iss2/6>

This Comment is brought to you for free and open access by the Law Reviews at Dickinson Law IDEAS. It has been accepted for inclusion in Dickinson Law Review by an authorized editor of Dickinson Law IDEAS. For more information, please contact lja10@psu.edu.

SECTION 113 OF THE PROPOSED COPYRIGHT LAW REVISION—A PROPOSED AMENDMENT TO PROTECT THE UTILITARIAN ASPECTS OF USEFUL ARTICLES*

"Useful articles" are articles which serve some functional or utilitarian purpose. Cigarette lighters, pens, chairs and guns are all useful articles and the list is unending. A proprietary interest in a useful article can be protected by obtaining a patent, but this process is costly and time-consuming because of the extensive examination the article undergoes in the Patent Office to determine whether it is a patentable invention. This delay could be avoided by using the copyright laws, but these statutes and the decisions interpreting them only grant protection to the two dimensional drawings or blueprints of the useful article. The three dimensional form of the article is not protected. Although copyright protection is established immediately upon publication and eliminates the delay, the inventor does not receive full protection.

Section 113 of the proposed Copyright Law Revision provides:
Scope of exclusive rights in pictorial, graphic, and sculptural works

(a) Subject to the provisions of clauses (1) and (2) of this subsection, the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106¹ includes the right to reproduce the work in or on any kind of article, whether useful or otherwise.

(1) This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such copyrighted works under the law in effect on December 31, 1968.

(2) In the case of a work lawfully reproduced in use-

* This article has been submitted to the Nathan Burkan Memorial Competition at Dickinson School of Law, 1968.

1. S. 597, 90th Cong., 1st Sess. § 106 (1967).

§ 106. Exclusive rights in copyrighted works

Subject to sections 107 through 116, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;

....

ful articles that have been offered for sale or other distribution to the public, copyright does not include any right to prevent the making, distribution, or display of pictures or photographs of such articles in connection with the advertisements or commentaries relating to the distribution or display of such articles, or in connection with news reports.

- (b) A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is a "useful article."²

This section is essentially a codification of existing case law with a few minor extensions. This Comment will analyze the copyright protection granted pursuant to this revision and will also investigate utility and design patent protection for useful articles. The deficiencies of current patent and copyright protection will be noted and an amendment to section 113 will be suggested to overcome these deficiencies by providing a hybrid patent-copyright protection for useful articles.

For the purpose of this Comment, "useful articles" shall mean "articles of manufacture,"³ thereby excluding machines, compositions of matter and processes. This would seem to comply with the definition of useful article found in section 113(b). Further, ornamental designs of articles of manufacture⁴ will not be considered useful articles. Thus, the utilitarian or functional aspect of the useful article is the only consideration.

CURRENT STATUTORY PROTECTION—COPYRIGHT AND PATENT

The utilitarian or functional aspects of useful articles are currently protected by the Patent Act. To obtain a patent for a useful article, an applicant must spend a minimum of \$65 to file the application⁵ and withstand the rigors of showing that the inven-

2. S. 597, 90th Cong., 1st Sess. § 113 (1967).

3. Patent Act, 35 U.S.C. § 101 (1952).

§ 101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Patent Act, 35 U.S.C. § 171 (1952).

§ 171. Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Patent Act, 35 U.S.C. § 41 (1952).

tion is novel,⁶ useful,⁷ and unobvious in view of the prior art.⁸ Because of the volume of applications in the Patent Office, the time from filing to allowance of claims in the patent is approximately three years. After the application is allowed and the issuance fee of \$100 is paid,⁹ the patented article is protected against infringements¹⁰ and the patentee is given the exclusive right to exclude others from making, using, or selling the useful article.¹¹ The patentee can not only exclude those who deliberately infringe the patent, but also those who have independently and innocently invented or infringed the invention.¹² Therefore, the *idea* of the invention is protected, not merely a particular *expression* of that idea. Under this reasoning "equivalents" of the invention are also considered an infringement.¹³

6. Patent Act, 35 U.S.C. § 102 (1952).

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

7. Patent Act, 35 U.S.C. § 101 (1952).

8. Patent Act, 35 U.S.C. § 103 (1952).

§ 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

9. Patent Act, 35 U.S.C. § 41 (1952).

10. Patent Act, 35 U.S.C. § 271 (1952).

§ 271. Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

See also Patent Act, 35 U.S.C. § 281 (1952), which grants a civil remedy for patent infringement.

11. Patent Act, 35 U.S.C. § 154 (1952).

§ 154. Contents and term of patent

Every patent shall . . . grant to the patentee . . . the right to exclude others from making, using, or selling the invention throughout the United States. . . .

12. Section 271 of Title 35 makes no distinction between those who have deliberately infringed and those who have innocently infringed.

13. The doctrine of equivalents states that there will be infringement of the claims of an issued patent if another device, method or the like per-

The patent laws also protect "new, original and ornamental design[s] for an article of manufacture."¹⁴ This protection specifically *excludes* designs for articles of manufacture when the design fulfills some functional or utilitarian purpose. In *Howe v. Blodgett & Co.*¹⁵ the scope of the protection afforded by the design patent was defined:

Patents for designs are intended to apply to methods of ornament, in which the utility depends upon the pleasing effect imparted to the eye, and not upon any new function. . . . Design patents refer to appearance, not utility. Their object is to encourage works of art and decoration which appeal to the eye, to the esthetic emotions, to the beautiful.¹⁶

A design patent application undergoes the same examination as a utility application with the resultant delay in issuance and protection. This delay from filing to issuance has motivated the introduction of more than sixty bills into Congress¹⁷ in an effort to obtain immediate protection for the ornamental designs of certain articles of manufacture—specifically dresses.¹⁸ None of these bills have passed. The dress industry has long had a need to protect dress designs immediately upon publication. Dress designs have value for a limited duration, and patent design protection, because of the delay in obtaining the patent, is essentially a right without a remedy since infringement proceedings cannot be

forms substantially the same function in substantially the same way to obtain the same result. See *Paul E. Hawkinson Co. v. Skegno-Gamble, Inc.*, 20 F. Supp. 543 (D. Minn. 1937).

14. Patent Act, 35 U.S.C. § 171 (1952).

15. 112 F. 61 (2d Cir. 1901).

16. *Id.* at 62.

17. See B. RINGER, *BIBLIOGRAPHY ON DESIGN PROTECTION* 27-49 (1955); *BIBLIOGRAPHY ON DESIGN PROTECTION*, 1959 SUPPLEMENT 44-71 (Strauss & Ringer ed. 1959).

18. For a discussion of attempts to get legislation in the design copyright area see Blunt, *Fighting the Design Pirate*, 15 J. PAT. OFF. SOC'Y 29 (1933); Callman, *Style and Design Piracy*, 22 J. PAT. OFF. SOC'Y 557 (1940); Ehrlich, *Copyright of Textile Design—Clarity and Confusion in the Second Circuit*, 59 MICH. L. REV. 1043 (1961); Hutchinson, *Design Piracy*, 18 HARV. BUS. REV. 191 (1940); Jackson, *Unfair Competition by Product Simulation v. Copyright Protection for Designs*, 45 J. PAT. OFF. SOC'Y 422 (1963); Lutz, *Can Ornamental Designs for Useful Articles be Protected by Copyright?—Constitutional Basis of the Wilson Bill*, 2 IDEA 289 (1958); Nikonow, *Patent Protection for New Designs of Dresses*, 17 J. PAT. OFF. SOC'Y 253 (1935); Solberg, *The Present Copyright Situation*, 40 YALE L.J. 184 (1931); Weikart, *Design Piracy*, 19 IND. L.J. 235 (1944); Note, *The Vestal Bill for the Copyright Registration of Designs*, 31 COL. L. REV. 477 (1931); Note, *Protection of the Artistic Aspects of Articles of Utility*, 72 HARV. L. REV. 1520 (1959); Note, *Protection of Styles and Designs in the Garment Industry*, 26 U. CINN. L. REV. 86 (1957). The most recent design bill, S. 1237, 89th Cong., 1st Sess. (1965), is given an exhaustive treatment in Comment, *Statutory Design Rights: Solution to the Unfair Competition of Piracy*, 34 GEO. WASH. L. REV. 110 (1965).

brought until issuance.¹⁹ These bills have been efforts to obtain copyright protection for a dress design by granting immediate protection without examination under the patent statute. Under this proposed legislation the embodiment of the design and not the idea would be protected, thereby preventing exact copying. When the design is for a functional and not ornamental purpose, the bills would not provide protection. A dress design is not currently copyrightable because it is not a "work of art" within the meaning of the existing copyright statute.²⁰ Although pictures of the design can be copyrighted, their three dimensional embodiment is not protected.²¹ Copyright of functional articles will be discussed in another section.²²

The current Copyright Act does not afford protection for utilitarian three dimensional useful articles. The Copyright Office defines what is copyrightable as follows:

If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.²³

Although there is some overlap between copyright and design patent protection,²⁴ a clear demarcation exists between copyright and utility patent protection. A patent protects an idea, but a copyright protects only the expression of an idea. Thus, to express the same idea in a different form is not copyright infringement so long as there is not exact copying; rather, it is patent infringement.²⁵ Copyright protection is established immediately

19. Patent Act, 35 U.S.C. § 271 (1952). This section specifically states that infringement can only occur "during the term of the patent."

20. See *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187 (S.D.N.Y. 1934):

A dress is not copyrightable. A picture of a dress is; . . . To give an author or designer an exclusive right to manufacture the art described in the certificate of copyright registration, when no official examination of its novelty has ever been made, would unjustly create a monopoly and moreover would usurp the functions of letters patent.

Id. at 189-90.

21. *Id.*

22. See text accompanying notes 34-58 *infra*.

23. 37 C.F.R. § 202.10(c) (1967).

24. For a discussion of the overlap of copyright and design patent protection see Sharpe, *Copyrights and Design Patents—The Common Zone Between*, 11 CLEV. MAR. L. REV. 336 (1962); Silverman, *Scope of Protection of Copyrights and Design Patents in the United States*, 24 U. PITT. L. REV. 21 (1962); Note, *Design Patents and Copyrights: The Scope of Protection*, 21 GEO. WASH. L. REV. 353 (1953); Note, *Design Patents and Copyrights: The Present Inadequate State of the Law*, 32 S. CAL. L. REV. 188 (1959).

25. See *Mazer v. Stein*, 347 U.S. 201 (1954); *Baker v. Selden*, 101 U.S. 99 (1879).

upon publication with the proper notice.²⁶ Patent protection does not become effective until approval by the Patent Office.²⁷ A copyrightable work need only be original,²⁸ but a patentable idea must be novel, unobvious, new and useful.²⁹ Copyright protection can extend for fifty-six years.³⁰ Utility patent protection lasts for seventeen years after issuance³¹ and design protection lasts for three and one-half, seven, or fourteen years after issuance.³²

Section 5(i) of the current Copyright Act does, however, protect "[d]rawings or plastic works of a scientific or technical character."³³ The following section is directed to an analysis of this provision.

CASE LAW INTERPRETING SECTION 5 (I)

The Copyright Office recognizes mechanical drawings, architect's blueprints and engineering diagrams as includable under section 5(i).³⁴ Blueprints showing functional useful articles are therefore copyrightable. As was noted, however, functional or utilitarian useful articles in their three dimensional form are not copyrightable. This dichotomy raises the question whether the three dimensional embodiment of the two dimensional copyrighted blueprint is protected by the two dimensional copyright. The answer is negative for functional or utilitarian useful articles. Articles which can qualify as "works of art," however, are currently protected in all mediums of expression. Section 113 of the proposed Copyright Law Revision is a codification of this anomaly. Subsection (a) gives the holder of a copyright in a "pictorial, graphic, or sculptural work . . . the right to reproduce the work in or on any kind of article, whether useful or otherwise."³⁵ But clause (1) of subsection (a) limits this right to reproduce in any form through incorporation by reference of current case law, which does not allow reproduction of useful articles in all mediums, but only in drawings.³⁶

There are two reasons for this limitation. First, the patent statutes preempt the question of copyright protection for utilitarian useful articles. To gain protection the useful articles must

26. Copyright Act, 17 U.S.C. § 10 (1947).

27. Patent Act, 35 U.S.C. § 1 (1952).

28. Copyright Act, 17 U.S.C. § 8 (1947); 37 C.F.R. § 202.1 (1967).

29. Patent Act, 35 U.S.C. §§ 101, 102, 103 (1952).

30. Copyright Act, 17 U.S.C. § 24 (1947).

31. Patent Act, 35 U.S.C. § 154 (1952).

32. Patent Act, 35 U.S.C. § 173 (1952).

33. Copyright Act, 17 U.S.C. § 5(i) (1947).

34. 37 C.F.R. § 202.12(a) (1967):

Works registrable in Class I include diagrams or models illustrating scientific or technical works or formulating scientific or technical information in linear or plastic form, such as, for example: a mechanical drawing, an astronomical chart, an architect's blueprint, an anatomical model, or an engineering diagram.

35. S. 597, 90th Cong., 1st Sess. § 113(a) (1967).

36. *Id.* § 113(a) (1).

comply with the requirements for invention. If they do not, no protection should be granted. Second, it is the *expression* of the three dimensional useful article that is protected by the two dimensional copyright and not the actual function of the useful article. The relevant cases demonstrate the distinction.

The landmark decision in this area is *Baker v. Selden*.³⁷ In this case a book which contained a series of lines for accounting purposes was copyrighted. Suit was brought against a person accused of infringing the copyright by employing much the same system of accounting. The Supreme Court held that the accounting *method* was not copyrightable; that is, it was not the use of the system of accounting that was copyrighted, but only the explanation of that use. Following *Baker* came a series of analogous cases in which the copyright holder had copyrighted a book that explained a plan or method of doing business. The book was protected, but the method or plan in actual use was not. Thus, in *Nikanov v. Simon & Schuster*³⁸ the plaintiff copyrighted a book on how to learn the Russian language and the defendant published a similar book. The court said: "[T]o the extent that [plaintiff] owns a new 'method' he owns nothing and when he accuses defendants of having stolen his 'method' he accuses them of no wrong."³⁹ In *Gaye v. Gillis*⁴⁰ the defendant was doing business using coupon books similar to those used by the plaintiff, who had copyrighted them. The court said: "A copyright does not cover an idea or a system of doing business but only the particular mode of expression of the idea embodied in the copyright material."⁴¹

37. 101 U.S. 99 (1879).

38. 144 F. Supp. 375 (S.D.N.Y. 1956).

39. *Id.* at 379.

40. 167 F. Supp. 416 (D. Mass. 1958).

41. *Id.* at 418. See also *Crume v. Pacific Mut. Life Ins. Co.*, 140 F.2d 182 (7th Cir. 1944); *Dorsey v. Old Surety Life Ins. Co.*, 98 F.2d 872 (10th Cir. 1938); *Aldrich v. Remington Rand*, 52 F. Supp. 732 (N.D. Texas 1942). In *Caddy-Imbler Creations, Inc. v. Caddy*, 299 F.2d 79 (2d Cir. 1962), the court found that a copyrighted booklet describing a method for using phonograph records was not infringed by a similar booklet describing the same method. In *Continental Cas. Co. v. Beardsley*, 151 F. Supp. 28 (S.D.N.Y. 1957), *aff'd*, 253 F.2d 702 (2d Cir. 1958), the plaintiff developed a plan for the replacement of lost stock certificates. He copyrighted the book describing the plan. Defendant used the plan and it was held that no infringement existed. The court said:

There is also no question that Beardsley's arrangement of contents in his proposal bond, however novel that arrangement may be, is not copyrightable, for the novelty of the arrangement is the key concept in the plan, and ideas and plans fall outside the copyright laws.

Id. at 34. In *Dunham v. General Mills*, 116 F. Supp. 152 (D. Mass. 1953), the plaintiff copyrighted masks with cut-out eyes. The defendant put cut-out masks on its cereal boxes just as plaintiff had. Since the defendant did not use the same masks, but only the idea of using cut-out masks, there was no copyright infringement. Finally, in *Loew's Inc. v. Columbia Broadcasting Sys.*, 131 F. Supp. 165 (S.D. Cal. 1955), the defendant did a burlesque of the plaintiff's copyrighted dramatic play. This was held to

From *Baker* various extensions of this "explanation versus use" doctrine developed. Copyrighted architectural blueprints have been held not to protect the three dimensional building depicted in the blueprint.⁴² The blueprint is protected because it is for the purpose of explanation; the building is not protected because it is for use. Drawings of parachutes,⁴³ dress designs,⁴⁴ bridges⁴⁵ and toys,⁴⁶ and photographs of furniture have been copyrighted.⁴⁷ In every instance, since the three dimensional embodiments were primarily for use and not explanation, the actual articles were held not to infringe the two dimensional copyright. The reason for these decisions is well stated in *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*:⁴⁸

To give an author or designer an exclusive right to manufacture the art described in the certificate of copyright registration, when no official examination of its novelty has ever been made, would unjustly create a monopoly and moreover would usurp the functions of letters patent.⁴⁹

On the other hand, drawings of tombstones⁵⁰ and cartoons⁵¹ have been copyrighted and their three dimensional embodiments

be infringement, however, since section 1(d) of Title 35 allows holders of a copyright in a dramatic work the right to perform the dramatic work in any manner or method. For a discussion of this case see 31 N.Y.U. L. Rev. 606 (1956); 28 Rocky Mt. L. Rev. 134 (1955).

42. *DeSilva Constr. Corp. v. Herrald*, 213 F. Supp. 184 (M.D. Fla. 1962); see *Scholz Homes, Inc. v. Maddox*, 379 F.2d 84 (6th Cir. 1967), where the court suggests that *Mazer v. Stein* may limit the *Baker* doctrine and alternatively that *Baker*, if literally read, may even allow copying of the architectural blueprint to some extent since it is the demonstration of a method for constructing a house. See generally H. BALL, *THE LAW OF COPYRIGHT AND LITERARY PROPERTY* 396 (1944); M. NIMMER, *COPYRIGHT* 147-51 (1967); 42 COL. L. REV. 290 (1942).

43. *Fulmer v. United States*, 103 F. Supp. 1021 (Ct. Cl. 1952).

44. *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187 (S.D.N.Y. 1934). See also *National Cloak & Suit Co. v. Standard Mail Order Co.*, 191 F. 528 (S.D.N.Y. 1911).

45. *Muller v. Triborough Bridge Auth.*, 43 F. Supp. 298 (S.D.N.Y. 1942).

46. *Seip v. Commonwealth Plastics*, 85 F. Supp. 741 (D. Mass. 1949).

47. See *Kashins v. Lightmakers, Inc.*, 155 F. Supp. 202 (S.D.N.Y. 1956), where the plaintiff put a photograph of a lamp into a catalogue and the defendant made the lamps from the photographs. The defendant then made photographs of its own lamps and made a catalogue. Since the lamp itself was not copyrightable, there was no infringement; *Lamb v. Grand Rapids School Furniture Co.*, 39 F. 474 (W.D. Mich. 1889), where the plaintiff published a book of engravings illustrating its furniture and the defendant made the furniture. There was no copyright infringement.

48. 112 F. Supp. 187 (S.D.N.Y. 1934).

49. *Id.* at 189-90.

50. *Jones Bros. v. Underkoffer*, 16 F. Supp. 729 (M.D. Pa. 1936). For a discussion of this case see 6 GEO. WASH. L. REV. 135 (1937).

51. *King Features Synd. v. Fleischer*, 299 F. 533 (2d Cir. 1924); see *Fleischer Studios v. Ralph A. Freundlich, Inc.*, 73 F.2d 276 (2d Cir. 1934), cert. denied, 294 U.S. 717 (1935), where a picture of a "Betty Boop" cartoon was infringed by a "Betty Boop" doll.

were held to infringe the drawings. Likewise a photograph of a copyrighted sculpture has been held an infringement.⁵² The apparent reason for protecting tombstones and cartoons and not the other named articles is that both the two dimensional expressions and the three dimensional embodiments are for the purpose of explanation; neither is for the purpose of use. A statutory basis for the distinction also exists. Section 1(b) of the Copyright Act allows the copyright holder to "complete, execute, and finish [the work] if [the work] be a model or design for a *work of art*."⁵³ Thus a "work of art" is protected in all mediums of expression. The Copyright Office, not the courts, has assumed the burden of defining works of art, and their definition does not include functional useful articles.⁵⁴ Since a work of art is primarily for explanation, any medium used for that explanation will also be a work of art. Conversely, a work of art itself will not be for the purpose of use. Given this reasoning, taken in conjunction with the purpose of the patent statutes, it is not difficult to understand why a stuffed toy of a cartoon character infringes the copyrighted cartoon drawing. The benefit of the toy or its commercial value is derived from the expression of the cartoon, which is a work of art and protected in all mediums of expression.

This use-explanation distinction may appear to lose some clarity, however, when for example a sculptured statuette is used as a lamp base specifically for commercial purposes. Is the statuette purely utilitarian because its use is to make a lamp? Is it a work of art *ab initio*, and does it remain a work of art when it is put to a purely utilitarian purpose? The Supreme Court in *Mazer v. Stein*⁵⁵ held that such a sculptured statuette was a work of art and therefore copyrightable under section 5(g).⁵⁶ That the statuette was mass produced as part of a lamp base did not make the statuette utilitarian. This case does not really modify any prior decisions because all that was protected by the copyright was the statuette itself. The copyright does not prevent others from using *different* statuettes as lamp bases. It only prevents others from copying the particular statuette. Thus the expression or explana-

52. *Bracken v. Rosenthal*, 151 F. 136 (N.D. Ill. 1907); see *Falk v. T.P. Howell & Co.*, 202 F. 202 (S.D.N.Y. 1888), where a photograph was infringed when it was converted to a design for chair backs by a second user.

53. Copyright Act, 17 U.S.C. § 1(b) (1947) (emphasis added).

54. 37 C.F.R. § 202.10(a) (1967).

(a) *General*. This class includes published or unpublished works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as works belonging to the fine arts, such as painting, drawings and sculpture.

55. 347 U.S. 201 (1954). For a discussion of this case see 4 CATHOLIC U. L. REV. 130 (1954); 39 CORNELL L.Q. 725 (1954); 42 GEO. L.J. 548 (1954); 22 GEO. WASH. L. REV. 764 (1954).

56. Copyright Act, 17 U.S.C. § 5(g) (1947).

tion was protected, but not the use. The Court also recognized that the question of copyrightability was determined by the object in question independently of how the object was later used. Section 113(a) of the proposed Copyright Law Revision codifies the *Mazer* case,⁵⁷ but section 113(a)(2)⁵⁸ does restrict the application of prior decisions. If pictures of the lamp were taken for any purpose, this would be copyright infringement under previous decisions. Section 113(a)(2) would allow photographs of a copyrighted work of art when that work is used for sale or distribution to the public as part of a useful article and the photographs are used in connection with advertisement, commentary relating to the distribution or display of the article, or news reports.

The cases clearly indicate, however, that when a three dimensional object is intrinsically utilitarian or functional, the copyright laws will not protect it. Any available protection is vested in the utility patent laws.

ARE THE UTILITY PATENT LAWS ADEQUATE?

The purpose of the patent laws is to ensure public disclosure of inventions so that all of society will benefit. In return the inventor is given the exclusive right to exclude others from making, using, or selling the invention for a limited period of time. Without patents the incentive to invent would be substantially impaired; upon public disclosure, the inventor would lose all rights to his invention and would therefore receive no reward for his contribution.⁵⁹ Absent patent protection, the inventor wanting to retain a proprietary interest in the article would have to avail himself of the protection afforded by the law of trade secrets.

A slight diversion is necessary to discuss trade secrets in light of the overall purpose of this Comment. As the name implies, a trade secret is a secret hidden from the public. If a company wishes to maintain a trade secret, it must follow several guidelines: non-disclosure agreements must be made with employees; no public disclosure of the information can be made by the company; and when dealing with other companies, the information must be kept confidential between the companies.⁶⁰ The concept of a trade secret would appear to directly contravene the policy of the patent statutes—public disclosure. In a large company the necessary controls are difficult to maintain, leading to the loss of the trade secret. For companies which produce useful articles,

57. S. 597, 90th Cong., 1st Sess. § 113(a) (1967).

58. *Id.* § 113(a)(2).

59. Anything in the public domain which is not patented or copyrighted may be freely copied. See *Sears, Roebuck & Co. v. Stiffel*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

60. See generally A. TURNER, *THE LAW OF TRADE SECRETS* (1962); Correa, *Protection of Trade Secrets*, 18 BUS. LAW. 531 (1963); Comment, *Industrial Protection of Preproduction Disclosures*, 72 DICK. L. REV. 160 (1967).

keeping these articles as trade secrets is particularly difficult if the company is planning to sell them publicly, since the secret is lost if it is disclosed upon examination of the article placed into commerce.⁶¹ Therefore, in the absence of patent protection, a producer of most useful articles has no protection. The patent laws would appear to be somewhat of a salvation, but they are not for some very practical reasons.

As has been noted, from the time that a patent application is filed to the time that it issues is approximately three years. Along with this time lag is the minimum \$165 fee for filing and issuance of each patent. Often a company engaged in research and development will submit proposals for new patentable useful articles to customers who might be interested. Because of the uncertainty that these proposals will be used by the customer and the high filing costs, the supplier company frequently will not file a patent application. To protect what the supplier company believes to be a proprietary interest in the proposals and to avoid a public disclosure, the company must rely upon the law of trade secrets to prevent its proposal from being lost to the public domain. This in turn will require the establishment of a confidential relationship between the companies. Companies which maintain a dominant market position, however, are using their economic power to contract away any confidential relationships which their suppliers attempt to establish.⁶² By negating the confidential relationship, the cus-

61. See *Houser v. Snap-On Tools Corp.*, 202 F. Supp. 181 (D. Md. 1962).

62. The following is a paraphrase of a letter which was sent from a customer to a supplier. The letter is to be copied by the supplier under its own letterhead, signed, and returned to the customer:

(Customer's address)

Attention:

Dear Sirs:

Because we (the supplier) are being allowed the opportunity to work with your engineers and to become familiar with your needs regarding (project or proposal) all of which is to our advantage, we agree and grant to you a free license which is both irrevocable and nonexclusive to make, use, sell or have made in this and all countries articles of manufacture, compositions of matter, machines and processes containing any patentable concepts conceived or obtained by us (the supplier) stemming from improvements upon concepts or invention you have disclosed to us in relation to the above named proposal. We recognize that the word "you" means present and future subsidiaries, and companies controlled by or associated with your central operation.

We further agree that we give you no license to patents or patent application filed in the United States Patent Office or issued by that office before the date of this agreement. We agree that no license is granted for patentable concepts conceived or obtained six (6) months after the termination of the work relating to the above named project or proposal.

We agree to inform you immediately of any patentable concepts that we decide to file on which relate to the license defined above, and we will send you a copy of the patent application.

Sincerely,
Supplier Company

tomer can reverse engineer the proposal or submit it for competitive bids to competitors of the supplier company. The competitors can supply the article at less cost than the supplier company because they do not have research and development costs to consider in their bids.

Even when the supplying company has filed a patent application, all its problems are not solved. The patent statutes offer no protection until the patent issues. If the prospective patentee decides to produce the useful article and place it into the public domain before a patent issues, any third party may make, use, or sell the useful article until the patent issues. The prospective patentee may affix a "patent pending" notice to the useful article, but this offers no protection and simply warns third parties that a patent may be forthcoming. Consequently, when the useful article is a type that sells for only a limited time, either because it is supplanted by an improvement or because the public buys it for only a short period, third parties may jump in and reap the benefit of the patentee's invention—including the research and development time.⁶³ When the useful article appears from the outset to have long term usefulness, however, potential infringers may be deterred from tooling up to produce it since they may lose their initial outlay after the issued patent causes their inability to legally produce the article.

Finally, there are those useful articles which do not disclose upon inspection how they are made. They essentially remain trade secrets until the patent issues and the benefit of public disclosure is delayed.

The proposed McClellan Bill⁶⁴ on patent revision attempts to overcome some of these shortcomings. To allow immediate public disclosure without the expenditure of large sums for application and to diminish the need for confidential relationships and trade secrets, the bill proposes a system of preliminary applications.⁶⁵

63. The President's Commission on the Patent System recognized this to be a very real problem. The Commission was suggesting publication of patent applications before they were issued as full-fledged patents. This would mean that the public would be aware of the invention before protection was granted. The Commission was attempting to avert this possibility, because it recognized the following problem:

With a requirement of pre-issuance publication of an application . . . anyone could copy the invention and make, use or sell it until a patent is issued, *possibly even exhausting its commercial value.*

Report of the President's Commission on the Patent System, *To Promote the Progress of . . . Useful Arts* 32 (1966) (emphasis added).

64. S. 1042, 90th Cong., 1st Sess. (1967).

65. S. 1043, 90th Cong., 1st Sess. §§ 111(a), (c) (1967).

§ 111. Application for patent

(a) An application for patent may be filed by either the inventor or the owner of the invention sought to be patented. The application shall be made in writing to the Commissioner, shall be signed by the applicant and include the name of each person be-

These applications would simply contain a description of the invention with minimal formal requirements and cost. They would establish a priority date for invention and permit a supplier company to disclose information to customers with the knowledge that all the information would be in the preliminary application. This procedure would partially prevent the need for trade secrets and allow the supplier company to buttress its proprietary position at little cost.⁶⁶ Several preliminary applications may be drawn together to form a completed application which must fulfill certain formal requirements.⁶⁷ If the supplier company found that its proposal to the customer was unacceptable, it could abandon its preliminary applications without filing a completed application.

To obtain immediate public disclosure, the McClellan Bill proposes that the completed application be publicly disclosed within eighteen months of its effective filing date.⁶⁸ A patentee may request that the completed application be disclosed earlier,⁶⁹ but in any event, at the time of allowance the completed application must be published, even if that time is less than eighteen months.⁷⁰ This publication would in part overcome the problem of lack of immediate public knowledge for those articles which do not disclose their inventiveness upon examination.

Since the application is to be published before the patent issues, the McClellan Bill suggests a new basis for infringement. The patentee may sue for damages prior to issuance if the following conditions are met: (1) the application is published; (2) the Patent Office allows the claim which appeared in the publication; and (3) notice is given to the alleged infringer telling him how his acts are considered to infringe the claim. In exchange for this right to sue during the interim period, the patentee would grant a nonexclusive license with a reasonable royalty for articles of manufacture made prior to issuance and extending beyond issuance.⁷¹ This provision would give slightly more protection for the

lied to have made an inventive contribution, and shall be accompanied by the prescribed fee.

... (c) A preliminary application containing the written description of an invention and otherwise complying with paragraph (a) of this section may be filed.

66. This is substantially the position of the Commission:

Information contained in these applications could be disclosed to the public without risk, through publication or market testing, for example, as long as a complete application was filed within twelve months of the earliest preliminary or foreign application relied on.

Report of the President's Commission on the Patent System, *To Promote the Progress of . . . Useful Arts* 9 (1966).

67. S. 1043, 90th Cong., 1st Sess. §§ 111(a), (b) (1967).

68. *Id.* § 123(a).

69. *Id.* § 123(b).

70. *Id.* § 151.

71. *Id.* § 273.

patentee by moving up the date an infringement suit is possible from issuance to allowance.

It is submitted that although the efforts of the McClellan Bill are commendable, at least in this area, they still do not substantially alleviate the previously enumerated problems. What is needed is a means to provide immediate protection for inventions. Any delay which allows those who have not participated in the invention process to benefit from it without paying for that benefit cannot be tolerated. Even the McClellan Bill provides no remedy for acts of infringement occurring between filing and allowance. Can a procedure which will allow immediate, low-cost protection be implemented without substantially detracting from the basic concepts of invention: novelty, usefulness and unobviousness? The day may come when computers can be sufficiently programmed to provide immediate protection by doing an instantaneous prior art search, but that is not so today. The following statute is suggested as an amendment to section 113 of the proposed Copyright Law Revision. The amendment is suggested because the McClellan Bill apparently will not be passed by Congress and in any event because the McClellan Bill does not provide the needed protection. The proposed amendment is made part of the Copyright Law Revision because the copyright provides the kind of immediate protection needed in this area.

A PROPOSED AMENDMENT TO SECTION 113

§ 113 Protection of the utilitarian and functional aspects of useful articles

- (a) Useful articles shall include articles of manufacture.
- (b) This section shall protect useful articles to the same extent that the Patent Act, Title 35, does with the enumerated exceptions.
- (c) The protection afforded by this section shall begin upon publication of the three dimensional embodiment of the useful article with the proper copyright notice as defined in subsection (c) (3), and shall last for three (3) years from the date of publication or until a patent issues, whichever event first occurs.
 - (1) Any public sale, use, or knowledge of the invention prior to publication with the proper copyright notice shall bar the use of this section.
 - (2) Prior to the three dimensional publication the inventor or his assigns must file a detailed drawing of the useful article along with a description of the inventive aspects of the useful article. The description shall indicate the inventive aspects of the invention by reference to the drawing.
 - (A) The drawing and the description shall be filed with the Copyright Office at which

- time the drawing and an abstract of the description shall be published by the Copyright Office.
- (B) Upon publication by the Copyright Office the inventor or his assigns may publish the useful article. Protection begins upon the three dimensional publication.
 - (C) Failure to comply with the above provisions shall invalidate any protection.
 - (3) The useful article shall have on it in a conspicuous place at the time of publication the following notice: date, name of copyright holder.
 - (d) The criteria for infringement of this copyright shall be the same as that found in the Patent Act, Title 35, except that the defense of independent discovery shall be available to the person charged with infringement.
 - (1) All defenses available to an alleged patent infringer shall be available to an alleged infringer of a useful article copyright.
 - (2) There shall be no presumption that the useful article copyright is valid in an infringement action.
 - (e) In the event that useful article copyright infringement is found, the only available remedy shall be a reasonable royalty imposed upon the infringing party for all acts of infringement during the term of the useful article copyright.
 - (f) Any person during the term of the useful article copyright may submit prior art to the Copyright Office to show that the copyright is invalid because it is not novel, useful, or unobvious within the meaning of the Patent Act, Title 35. Upon determination by the Copyright office that such information does invalidate the useful article copyright, notice of invalidation shall be published.
 - (g) Any conflict with Title 35 and this section shall be resolved in favor of Title 35.

Recognizing that there is very little new in the world, a first reaction to this proposal might be that it is simply a restatement of the foreign systems which do not require extensive examination in their patent offices and which allow any controversies to be resolved in the courts.⁷² Such a statement is partially true, but the differences are significant. First, the period of protection is abbreviated to three years or until a patent issues on the useful article. This section thus embraces the period during which a

72. For a discussion of foreign patent laws see H. SCHEER, *INTERNATIONAL PATENT, DESIGN AND TRADEMARK LAW* (1962); LANGNER, PARRY, CARD & LANGNER, *FOREIGN PATENTS* (4th ed. 1951); WHITE & RAVENSCROFT, *PATENTS THROUGHOUT THE WORLD* (2d ed. 1967).

patent is being examined. The prospective patentee could not unduly overextend this copyright protection with patent protection on the same useful article since the public disclosure required by this section would invoke the statutory bar of section 102 of Title 35⁷³ and give the prospective patentee one year to file for a patent. Although the prospective patentee could receive a maximum of 20 years protection by using this section plus the 17 year protection under Title 35, this term does not seem unwarranted since the McClellan Bill and the President's Advisory Commission on the Patent System both recommended a 20 year term from the date of filing.⁷⁴

A considerable amount of current copyright law is incorporated into this section. Public disclosure without the proper filing procedures and notice bars use of this section just as publication without the proper copyright notice invalidates any copyright.⁷⁵ The defense of independent discovery limits the scope of the amendment's protection. The standard copyright is not infringed if the alleged infringer can prove that he did not copy the work,⁷⁶ and it is felt that inclusion of this defense will diminish lengthy litigation since proof of independent discovery may not be as difficult as the standard patent defenses. Furthermore, this defense comports with the general attempt to correlate this section with the other provisions of the current Copyright Act and the proposed act. The provision that no presumption of validity shall be accorded a useful article copyright is necessary because no formal examination of the useful article is made to determine its inventiveness.

The ex parte opposition proceeding in the Copyright Office affords the public the right to invalidate the useful article copyright without involved litigation.⁷⁷ The only problem is that the task of examination, heretofore exclusively within the jurisdiction of the Patent Office, is shifted to the Copyright Office. This divi-

73. Patent Act, 35 U.S.C. § 102 (1952).

74. See S. 1042, 90th Cong., 1st Sess. § 154 (1967); Report of the President's Commission on the Patent System, *To Promote the Progress of . . . Useful Arts* 33 (1966). The primary reason for this provision as noted by the Commission is:

The term of a U.S. patent now extends for a period of seventeen years from the date of issuance. Measuring the patent term from this point encourages deliberate delays in the prosecution of applications, particularly those filed primarily for speculative reasons and those having little immediate value. Another effect can be the filing of continuing applications solely to delay the start of a patent term.

Id.

75. See *Metro Assoc. Serv. Inc. v. Webster City Graphic, Inc.*, 117 F. Supp. 224 (N.D. Iowa 1953); *Wrench v. Universal Fixtures Co.*, 104 F. Supp. 374 (S.D.N.Y. 1952).

76. Copyright Act, 17 U.S.C. § 1 (1947).

77. Opposition proceedings are not repugnant to our system. The McClellan Bill provided for such opposition. See S. 1042, 90th Cong., 1st Sess. § 136 (1967).

sion of function may cause some unnecessary expense. Such administrative problems are somewhat diminished, however, when it is recognized that many articles receiving useful article copyrights will have been filed in a patent application. The Patent Office could then easily submit an advisory opinion regarding the opposition. When no patent application has been made, the Copyright Office and Patent Office may have to cooperate to resolve the opposition proceeding.

If the useful article copyright is determined invalid, the copyright holder may come in to defend his position. This could be done by appeal to the Court of Customs and Patent Appeals. The scope of the invention would be defined by the detailed description included with the filing. Although this system does shift the burden of examination to the public, the equities are balanced by granting immediate protection to the public. The public examination process could be somewhat facilitated if the Copyright Office would publish the drawings and description by a classification corresponding to the Patent Office classification. For two persons filing concurrently, a first-to-file priority system should be adopted to eliminate the need for interference proceedings.⁷⁸

One nagging concern about this proposal is that the country will be deluged with unpatentable articles protected under the proposed copyright amendment. But the current patent system is already flooding the country with unpatentable articles, at least as far as the courts are concerned. The number of patents held valid and infringed in infringement suits is pitifully small.⁷⁹ Of course, strong patents are never involved in litigation because of their strength. The same should be true of strong useful article copyrights. Even assuming that an unprecedented number of unpatentable articles are protected by this section, the opposition proceeding can remove them at low cost since the need for an infringement proceeding is substantially lessened. The copyright can be declared invalid in an *ex parte* proceeding instead of an adversary proceeding. If damages are significant, of course, an infringement suit would be advisable.

Essentially what is proposed is the protection of an idea and not the expression of that idea. This is patent language in a copyright setting. The proposal is limited to articles of manufacture and leaves intact those cases holding that a method or plan for doing something is not protected by copyright. It is simply an effort to protect useful articles at an earlier date than they are now protected, recognizing that the reason for the delay is the administra-

78. See Report of the President's Commission on the Patent System, *To Promote the Progress of . . . Useful Arts* 5 (1966).

79. For an analysis of patent infringement cases noting the disparity in the circuits see STAFF OF SUBCOMM. ON PATENTS, TRADEMARKS AND COPYRIGHTS OF THE SENATE COMM. ON THE JUDICIARY, 86TH CONG., 2D SESS., AN ANALYSIS OF PATENT LITIGATION STATISTICS (Comm. Print 1961).

tive process. With built-in safeguards such as the limited protection period and the opposition proceeding, the courts should not be flooded with useful article infringement suits. For a brief period a party may hold a legal upper hand with an unpatentable article, but the benefits for those who have spent engineering and research time and money to develop new articles seem to fulfill the policy of protecting an inventor's proprietary information for a limited time.

CONCLUSION

Current statutory copyright and patent protection of useful articles is generally unsatisfactory. The current copyright law does not protect functional useful articles. The patent statutes do protect such articles, but delay in the patent office and expensive filing and issuance fees prohibit their total effectiveness. The proposed Copyright Law Revision does not appreciably improve this situation. The amendment herein proposed to section 113 of the proposed Copyright Law Revision would extend a hybrid patent-copyright protection to useful articles for a limited period so that the inventor's rights are fully protected.

GARY R. MYERS